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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,430	08/13/2001	Patricia S. Kruse	10010789-1	9651

7590 09/20/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
MILIA, MARK R	
ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,430

Applicant(s)

KRUSE, PATRICIA S.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 27 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/27/05, and has been entered and made of record. Currently, claims 1-32 are pending.

Drawings

2. Applicant's amendments to Figs. 1, 4, 6, and 7 to delete reference characters not described in the specification has overcome the objection to the Drawings cited in the previous Office Action. The amendment to the specification to include reference character (808) has overcome the objection to Fig. 8 as cited in the previous Office Action. Therefore the objection to the Drawings has been withdrawn.

Response to Arguments

3. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Particularly, applicant's arguments with respect to claims 1, 2, 7, 9, 10, 15, 17, 18, 23, 25, 26, and 31 are persuasive and the Examiner agrees that the reference of Kanerva fails to disclose a set of individual printing characteristics for each of the files or

specify a set of individual packaging characteristics with respect to each of the files as recited in currently amended claims 1, 9, 17, and 25.

Applicant's arguments with respect to claims 3-6, 8, 11-14, 16, 19-22, 24, 27-30, and 32 are not persuasive and the Examiner disagrees that the reference of Hicks fails to disclose the limitations recited in the above-mentioned claims. More specifically, with regard to claims 3, 11, 19, and 27, Hicks discloses "identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files" (see column 7 line 10-column 11 line 6, reference shows that there are four different document types analogous to subsets of files as recited in the above limitation, also the subsets contain different information even though the information is based on the master document, as the other documents can contain additional information or less information, and the different document types can be printed in different output stacks, some being for general distribution "handout set" and some being for the presentation package "transparency set", all of this is analogous to the recited claim limitation and is disclosed in the reference of Hicks) as recited in the currently amended claims. With regard to the remaining claims, the above argument applies as the reference of Hicks discloses identifying subsets and indicating a number of copies to be printed (see column 9 lines 60-67).

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5579087 to Salgado.

Regarding claims 1, 9, and 17, Salgado discloses a system comprising: adding a plurality of files to a presentation profile (see Figs. 4-6 and column 6 lines 15-42), specifying a set of individual printing characteristics with respect to each of the files (see column 5 lines 40-49), specifying a set of individual packaging characteristics with respect to each of the files (see column 7 lines 7-19), and responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files (see column 5 line 66-column 6 line 14).

Regarding claim 25, Salgado discloses a user interface comprising: a first area for adding a plurality of files to a presentation profile (see Figs. 4-6 and column 6 lines 15-42), a second area for specifying a set of individual packaging characteristics with respect to individual each of the files (see column 7 lines 7-19), a third area for indicating a set of individual printing characteristics with respect to individual each of the files (see column 5 lines 40-49), and a fourth area for printing a presentation package including each of the files in the presentation profile in response to a single print

request, the printing being characteristics and individual printing based on the individual packaging characteristics corresponding to each of the files (see column 5 line 66-column 6 line 14).

Regarding claims 4, 12, 20, and 28, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files (see column 5 line 66-column 6 line 14 and column 7 lines 7-19).

Regarding claims 6, 14, 22, and 30, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses indicating a number of copies to print with respect to a first subset of the files that are to be included in the presentation package (see column 7 lines 11-19).

Regarding claims 7, 15, 23, and 31, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses identifying a specific printer to print each of the files (see column 6 line 54-column 7 line 10).

Regarding claims 8, 16, 24, and 32, Salgado discloses the system discussed in claims 1, 9, 17, and 25, and further discloses indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files (see Fig. 1 (11), column 5 lines 40-49, and column 7 lines 11-19, reference states that the user can specify the type of paper stock which inherently comes from a media supply bin).

Claim Rejections - 35 USC § 103

6. Claims 2, 10, 18, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado as applied to claims 1, 9, 17, and 25 above, and further in view of Kanerva.

Salgado does not disclose expressly wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.

Kanerva discloses wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application (see column 6 lines 11-16, column 9 lines 28-34, column 10 lines 46-51, and column 13 lines 18-23).

Salgado & Kanerva are combinable because they are from the same field of endeavor, printing compound documents containing a plurality of individual job segments.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of subsets containing files generated from different computer program applications as described by Kanerva with the system of Salgado.

The suggestion/motivation for doing so would have been to allow different kinds of documents to be processed and printed together to increase efficiency and grant the user greater control (see column 1 lines 12-35 and column 3 lines 30-60 of Kanerva).

Therefore, it would have been obvious to combine Kanerva with Salgado to obtain the invention as specified in claims 2, 10, 18, and 26.

7. Claims 3, 5, 11, 13, 19, 21, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salgado as applied to claims 1, 9, 17, and 25 above, and further in view of Hicks.

Regarding claims 3, 11, 19, and 27, Salgado does not disclose expressly identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

Hicks discloses identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files (see column 7 line 10-column 11 line 6, particularly column 8 lines 25-34, column 9 lines 60-67, and column 10 line 1-column 11 line 6).

Regarding claims 5, 13, 21, and 29, Salgado discloses indicating a number of copies to print with respect to a first subset of the files that are to be included in the presentation package (see column 7 lines 11-19).

Salgado does not disclose expressly identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

Hicks discloses identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package (see Figs. 3 and 4, column 8 lines 25-35, and column 9 line 60-column 11 line 6).

Salgado & Hicks are combinable because they are from the same field of endeavor, printing compound documents containing a plurality of individual job segments.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the use of subsets to categorize files for distribution and presentation as described by Hicks with the system of Salgado.

The suggestion/motivation for doing so would have been to provide increased flexibility and efficiency in producing compound documents for distribution.

Therefore, it would have been obvious to combine Hicks with Salgado to obtain the invention as specified in claims 3, 5, 11, 13, 19, 21, 27, and 29.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent numbers 6393231 (Okawa et al.) and 6674540 (Weichers et al.).

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRM

Mark R. Milia
Examiner
Art Unit 2622


EDWARD COLES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600